

REMARKS

Claims 1-8 and 10-34 are pending. Claims 1 and 32-34 are amended. The basis for the amendments can be found, for example, at paragraph 23 on page 7, paragraph 35 on page 10, and paragraph 45 spanning pages 12-13. Claim 35 is cancelled.

Claims 32-35 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly unclear. While not necessarily agreeing with the rejection, claim 1 is amended to recite as optional elements the components of claims 32-34. Claim 35 is cancelled. Thus, the dependent claims do not add additional elements to amended claim 1.

Claims 32-35 were rejected under 37 C.F.R. § 1.75(c) as allegedly being improper dependent claims. As discussed in the previous paragraph, amended claim 1 includes, as optional elements, the materials of claims 3-34. Claim 35 is canceled. Thus, the claims are proper and do further limit the scope of claim 1.

Claims 1-8, 10-22, 24-25, 27-31, and 34-35 were rejected as allegedly anticipated under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,994,493 ("the Krebs patent"). Claim 1, the only independent claim pending in the present application, was previously amended to recite that the reactive adhesive comprises at least one reaction product having free isocyanate groups obtained by reacting reactants *consisting of* certain specified components (i.e., diphenylmethane diisocyanate, including at least 95 wt.% of 2,4'-diphenylmethane diisocyanate; and at least one compound selected from the group consisting of polyether-polyols having number average molecular weights less than 1,000, polyalkylene diols having number average molecular weights less than 1,000, and polyester-polyols which are crystalline, partly crystalline or vitreously amorphous). The reactants which are reacted to form the reaction product having free isocyanate groups do not include an aromatic polyol residue in the product as required by the Krebs patent.

Thus, there can be no overlap between the instant claims and the claims or teachings of the Krebs patent. Indeed, the Krebs patent is directed to a significantly different product as it requires the use of (1) an isocyanate, (2) a polyester polyol or polyether polyol and (3) *an aromatic polyol* to form the reaction product. See, for example, the Abstract and column 4, lines 23-39. In contrast, the claims of the instant application are limited such that the reaction product present in the reactive adhesive cannot have been prepared using an aromatic polyol.

Anticipation requires strict identify. Because the Krebs patent teaches the requirement of an aromatic polyol and does not teach a composition prepared without use of an aromatic polyol, the instant claims are not anticipated by the cited art.

Claims 1-8, 10-22, 24, 25, 27-31, 34, and 35 were rejected on the ground of alleged nonstatutory obvious-type double patenting over claims 1-29 of the Krebs patent. Claims 1-8 and 10-35 were also rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Krebs patent. Applicants respectfully traverse both rejections. As both rejections concern obviousness allegations based on the same art, they are discussed together. Because, as discussed below, the instant claims are not obvious under 35 U.S.C. § 103(a) over the total disclosure of the Krebs patent, they are also not obvious over only the claims of the Krebs patent as analyzed for obviousness type double patenting.

To establish a *prima facie* case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants disclosure, such as in the prior art, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the instant rejection does not meet these requirements.

As discussed above, claim 1, the only independent claim pending in the present application, was previously amended to recite that the reactive adhesive comprises at least one reaction product having free isocyanate groups obtained by reacting reactants *consisting of* certain specified components (i.e., diphenylmethane diisocyanate, including at least 95 wt.% of 2,4'-diphenylmethane diisocyanate; and at least one compound selected from the group consisting of polyether-polyols having number average molecular weights less than 1,000, polyalkylene diols having number average molecular weights less than 1,000, and polyester-polyols which are crystalline, partly crystalline or vitreously amorphous). The reactants which are reacted to form the reaction product having free isocyanate groups do not include an aromatic polyol residue in the product as required by the Krebs patent.

Thus, there can be no overlap between the instant claims and the claims or teachings of the Krebs patent. Indeed, the Krebs patent is directed to a significantly different product as it requires the use of (1) an isocyanate, (2) a polyester polyol or polyether polyol and (3) *an aromatic polyol* to form the reaction product. See, for example, the Abstract and column 4, lines 23-39. In contrast, the claims of the instant application are limited such that the reaction product present in the reactive adhesive cannot have been prepared using an aromatic polyol. Because the Krebs patent teaches the requirement of an aromatic polyol and does not teach or suggest a composition prepared without use of an aromatic polyol, the instant claims are not obvious in view of the cited art.

In making the rejection the Office alleges that the cited art teaches use of polyols that overlap with those of claim 1. Even if this is true, the art is still directed to a significantly different product as it requires an aromatic polyol that is restricted from the instant claim language. For at least these reasons, reconsideration and withdrawal of the rejections is respectfully requested.

In regard to claim 2, Applicants note that the cited art does not teach or suggest an adhesive having a monomeric diisocyanate content that is less than 0.25 weight percent. Likewise there is no teaching or suggestion of the less than 0.3 wt.% of 2,2'-diphenylmethane diisocyanate, less than 0.1 wt.% of 2,2'-diphenylmethane diisocyanate, and less than 0.06 wt.% of 2,2'-diphenylmethane diisocyanate, limitations recited in claims 6, 7, and 8 respectively. For at least these reasons, Applicants submit that the anticipation and obviousness rejections should be withdrawn as applied to these claims.

DOCKET NO.: HENK-0066/H5395
Application No.: 10/822,625
Office Action Dated: May 21, 2007

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Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Date: November 20, 2007

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Respectfully submitted,

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